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DK

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 09/248,382 | 02/10/99 | MUKHERJEE R | 0012104-2 |

HM22/1122

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| EXAMINER | |
|---|---|
| MOEZIE,F | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1654 | |

DATE MAILED: 11/22/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

| Office Action Summary | Application No. 09/248,382 | Applicant(s) Mukherjee et al. |
|---|---|---|
| | Examiner F. Moezie | Group Art Unit 1654 |

*—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE One MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

☒ Responsive to communication(s) filed on 2/10/99.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

**Disposition of Claims**

☒ Claim(s) 1-31 is/are pending in the application.

Of the above claim(s)_____ is/are withdrawn from consideration.

☐ Claim(s)_____ is/are allowed.

☐ Claim(s)_____ is/are rejected.

☐ Claim(s)_____ is/are objected to.

☒ Claim(s) 1-31 are subject to restriction ~~or~~ and election requirement.

**Application Papers**

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on_____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on_____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)_____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received:_____.

**Attachment(s)**

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s)._____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☒ Other Notice to comply with aa sequence requirement

**Office Action Summary**

## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-2, drawn to a peptide (IA) and claims 3 and 4, drawn to a method for treating cancer (IB), classified in class 530, subclass 328, for example.

II. Claims 5-8, drawn to a peptide (IIA) and claim 10, drawn to a method for treating cancer (IIB), classified in class 514, subclass 16, for example.

III. Claims 9, drawn to a peptide (IIIA) and claim 11, drawn to a method for treating cancer (IIIB), classified in class 514, subclass 16, for example.

IV. Claims 12 and 14, drawn to a peptide (IVA) and claims 15 and 17, drawn to a method for treating cancer (IVB), classified in class 514, subclass 15, for example.

V. Claims 13 and 15, drawn to a peptide (VA) and claim 18, drawn to a method for treating cancer (VB), classified in class 514, subclass 15, for example.

VI. Claim 16, drawn to a peptide (VIA) and claim 19, drawn to a method for treating cancer (VIB), classified in class 530, subclass 326, for example.

VII. Claim 20, drawn to a peptide (VIIA) and claim 23, drawn to a method for treating cancer (VIIB), classified in class 530, subclass 327, for example.

VIII. Claim 21, drawn to a peptide (VIIIA) and claim 24, drawn to a method for treating cancer (VIIIB), classified in class 514, subclass 14, for example.

IX. Claim 22, drawn to a peptide (IXA) and claim 26, drawn to a method for treating cancer (IXA), classified in class 514, subclass 8, for example.

X. Claim 26, drawn to a peptide (XA) and claim 29, drawn to a method for treating cancer (XB), classified in class 530, subclass 328, for example.

XI. Claim 27, drawn to a peptide (XIA) and claim 30, drawn to a method for treating cancer (XIB), classified in class 514, subclass 16, for example.

XII. Claim 28, drawn to a peptide (XIIA) and claim 31, drawn to a method for treating cancer (XIIB), classified in class 514, subclass 16, for example.

2. The inventions are distinct, each from the other because of the following reasons: Any of the inventions IA, IB to XIIA, XIIB are distinct one from the other. Inventions are distinct because each invention utilizes a distinct peptide or family of peptides wherein each peptide has its own distinct structure, ie, amino acid sequence, method of making the peptide and its own physicochemical properties and/or functions. See the instant Abstract. Moreover, cancer can be treated by agents other than the claimed peptides such as taxol or radiation therapy.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group IA, for example, is not required for Group IIA or any other Group of the invention as cited above, therefore restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that for the response to this requirement to be complete, an election of the invention to be examined must be indicated, even if the requirement is traversed (37 C.F.R. 1.143).

In the event applicant elects Group IA, for example, and the elected invention is found patentable, the examiner will consider a rejoinder between the peptide(s) and their methods of use.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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In addition to the foregoing, applicants are required under 35 U.S.C. 121 to elect a single disclosed specie for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. A "specie" is a specific peptide, which is fully described structurally, or else described by the textual description of sufficient detail that the structure can be determined.

7. This application contains claims directed to the following patentably distinct species of the claimed invention: SEQ ID NO: 1, --- SEQ ID NO 9, SEQ ID NO: 11, --- SEQ ID NO 17, SEQ ID NO: 19, SEQ ID NO 23, SEQ ID NO 25 and SEQ ID NO 27 to 29.

Each specie is distinct form the other and a reference which would obviate one of the species may not obviate any other species - absent ancillary reference(s).

Applicant is advised that a reply to this requirement must include an identification of the specie that is elected consonant with this requirement, and a listing of the claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

This application fails to comply with the amino acid sequence requirement of 37 CFR 1.821 through 1.825.

***The attached notice to comply with requirement for patent Applications containing amino acid sequence disclosures is provided herein.***

8. Any inquiry concerning this communication should be directed to F.T.Moezie at telephone number (703) 305-4508 or Mr. Woodward (SPE) at 308-4028.

F.T. Moezie

F. T. MOEZIE, Ph.D.
PRIMARY EXAMINER
ART UNIT ~~180~~ 1654